

RESPONSE TO OFFICE ACTION MAILED AUGUST 28, 2003
Patent Application No. 09/734,432

RESPONSE

Remarks

Applicant prepared the pending application as a pro-se Applicant.

Applicant has now engaged a patent attorney to respond to the Office Action.

Claims 1-20 are pending in the Application. Claim 1, 5, 10 and 16 are in independent format. Applicant now responds to the Examiner's assertions.

The Applicant asks the Examiner carefully consider the comments below with an open mind. If the Examiner carefully and realistically considers the comments below with an open mind she will see that her rejections are improper, violate the holdings of many different court decisions and cannot be maintained.

Oath/Declaration

The Examiner rejected the original oath or declaration as defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filed is attached hereto.

Specification

The Examiner objected to the Specification because of the informalities related to a claim to a U.S. Provisional application. The Specification has been amended based on the Examiner objections.

13 of 21

LESVICH HIGH-TECH
LAW GROUP, P.C.
SUITE 325
39 SOUTH LA SALLE STREET
CHICAGO, ILLINOIS 60603
TELEPHONE (312) 332-3761

RESPONSE TO OFFICE ACTION MAILED AUGUST 28, 2003
Patent Application No. 09/734,432

Abstract

The Examiner objected to the Abstract because of typing mistakes. The Abstract has been amended to correct the typing mistakes as requested by the Examiner.

Claims

The Examiner objected to claims 1-11 because of numerous typing mistakes. Claims 1-5 and 7-11 have been amended to correct typing mistakes as requested by the Examiner and other typing mistakes noticed by the Applicant.

First Section 103 Rejection

The Examiner asserts Claims 1 and 4 are rejected under U.S.C. §103(a) as being unpatentable over Musgrave et al ("Musgrave"), U.S. Patent No. 6,505,193. The Applicant traverses all of the Examiner's assertions, accepts all the Examiner's admissions, and responds as follows. Applicant specifically responds to selected assertions made by the Examiner, but still intends that all the assertions are traversed.

14 of 21

LESAVICH HIGH-TECH
LAW GROUP, P.C.
SUITE 325
39 SOUTH LASALLE STREET
CHICAGO, ILLINOIS 60603
TELEPHONE (312) 332-3751

RESPONSE TO OFFICE ACTION MAILED AUGUST 28, 2003
Patent Application No. 09/734,432

First Section 103 Response

Claims 1 and 4

The Examiner is reminded that to establish *prima facie* obviousness of a claimed invention in the first place, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981 (CCPA 1974).

The Examiner admits that "Musgrave does not expressly state using an index generation means." The Applicant accepts the Examiner's admissions with respect to Claims 1 and 4. Thus, Musgrave does not teach or suggest all of the claim limitations. Therefore, the Applicant submits the Examiner has failed to establish *prima facie* obviousness based on the teachings of Musgrave.

The Examiner is also reminded to that even if a *prima facie* case of obviousness is established by an Examiner, which is not the case here, the *prima facie* case of obviousness may be rebutted by showing the prior art, in any material aspect, teaches away from the claimed invention. *In re Geisler*, 116 F.3d 1465, 1471 (Fed. Cir. 1997).

The Examiner further asserts that "indices are pointers to the database locations (Spec. page 9, line 20) Musgrave discloses using digital certificates to point to a database partition having stored biometric images (Abstract, lines 4-10; Col. 5, line 67, Col. 6, lines 1-6). Therefore it would have been obvious to one of ordinary skill in the art to have modified the digital certificates used by Musgrave

15 of 21

LESAVICH HIGH-TECH
LAW GROUP, P.C.
SUITE 325
30 SOUTH LA SALLE STREET
CHICAGO, ILLINOIS 60603
TELEPHONE (312) 322-3751

RESPONSE TO OFFICE ACTION MAILED AUGUST 28, 2003
Patent Application No. 09/734,432

to include explicitly stating using an index to point to database locations because it narrows the database search which allows for expedited and reliable identification (Abstract, lines 13-20)."

Claim 1 recites an index generation means for dynamically generating one or more indices from the information signal, wherein the one or more indices are created by processing the information signal.

In direct contrast, Musgrave recites at Col. 5, lines 48-51 "A digital certificate (DC₁, DC₂, DC₃, DC_n) can be assigned by the certifying authority and identity server 851 and is attached to each of the computing platforms CP. At Col. 5, lines 61-67 Musgrave teaches the transmitted digital certificate is compared to stored digital certificates that have been assigned to computing platforms CP in order to authenticate the computing platform CP as being an enrolled computing platform for that application. At Col. 6, lines 21-22 Musgrave teaches the digital certificate includes a character string assigned to a computing platform. Musgrave at Col. 6, lines 36-40 teaches however, while digital certificates are useful in positively identifying a computing platform as being an authorized platform for a particular application, they do not necessarily identify the person at the computing platform sending the request.

In the claimed invention, the one or more indices are created from an information signal impressed with characteristics of a body part. In direct contrast, the digital certificate of Musgrave includes a character string assigned

16 of 21

LESAVICH HIGH-TECH
LAW GROUP, P.C.
SUITE 226
39 SOUTH LA SALLE STREET
CHICAGO, ILLINOIS 60603
TELEPHONE (312) 332-3751

RESPONSE TO OFFICE ACTION MAILED AUGUST 28, 2003
Patent Application No. 09/734,432

to computing platform and is used to authenticate the computing platform. Thus Musgrave teaches away in a material aspect from what is recited by the claimed invention. Therefore, even if the Examiner has established a prima facie case of obviousness, it is rebutted under the holding of *In re Geisler*.

Thus, the claimed invention can not be obvious over Musgrave. Therefore, the Applicant now requests the Examiner immediately withdraw the §103 rejections with respect to Claims 1 and 4. Since these claims are not obvious they should be immediately allowable in their present form.

Second Section 103 Rejection

The Examiner asserts Claims 2, 3, 5, 6, 8-11 are rejected under U.S.C. §103(a) as being unpatentable over Musgrave in view of Davida et al. (*On Enabling Secure Application Through Off-line Biometric Identification*). The Applicant traverses all of the Examiner's assertions, accepts all the Examiner's admissions, and responds as follows. Applicant specifically responds to selected assertions made by the Examiner, but still intends that all the assertions are traversed.

Second Section 103 Response

Claims 2, 3, 5, 6, 8-11

With respect to Claim 2, the Examiner admits that "Musgrave does not appear to recognize the index as a function of a subset of a data signal."

17 of 21

LESAVICH HIGH-TECH
LAW GROUP, P.C.
SUITE 325
28 SOUTH LASALLE STREET
CHICAGO, ILLINOIS 60603
TELEPHONE (312) 332-3751

RESPONSE TO OFFICE ACTION MAILED AUGUST 28, 2003
Patent Application No. 09/734,432

With respect to Claim 3, the Examiner admits that "Musgrave does not appear to recognize the index generation including means to generate one or more indices each from different partial information from the information or transformation of the information."

With respect to Claim 5, the Examiner admits that "Musgrave does not recognize including information hiding means to the body part input."

With respect to Claim 6, the Examiner admits that "Musgrave does not appear to recognize multiple readings."

With respect to Claim 8, the Examiner admits that "Musgrave does not appear to recognize where the verification is a hamming weight test."

The Applicant accepts all the Examiner's admissions.

All of the 103 arguments with respect to Claims 1 and 4 discussed above are incorporated herein by reference.

In addition, Claims 5 and 10 are independent claims with additional limitations not recited by independent claim 1. Applicant has clearly explained by Claim 1 is not obvious. By similar arguments independent Claims 5 and 10 are not obvious.

Claims 2, 3, 8, 9 and 11 are dependent claims that add additional limitations to the invention not taught by Musgrave. Since the Applicant has clearly pointed out why the independent claims are not obvious, their corresponding dependent claims are not obvious. The Examiner is reminded

18 of 21

LESAVICH HIGH-TECH
LAW GROUP, P.C.
SUITE 325
30 SOUTH LA SALLE STREET
CHICAGO, ILLINOIS 60603
TELEPHONE (312) 332-3751

RESPONSE TO OFFICE ACTION MAILED AUGUST 28, 2003
Patent Application No. 09/734,432

that if an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

Therefore, the Applicant now requests the Examiner immediately withdraw the §103 rejections with respect to Claims 2, 3, 5, 6, 8-11. Since these claims are not obvious they should be immediately allowable in their present form.

Third Section 103 Rejection

The Examiner asserts Claim 7 is rejected under U.S.C. §103(a) as being unpatentable over Musgrave in view of Davida and further in view of Canetti (*Towards Realizing Oracles: Hash Functions that Hide all Partial Information*).

The Applicant traverses all of the Examiner's assertions, accepts all the Examiner's admissions, and responds as follows. Applicant specifically responds to selected assertions made by the Examiner, but still intends that all the assertions are traversed.

Third Section 103 Response

Claim 7

With respect to Claim 7, the Examiner admits that "Davida does not appear to recognize using exclusive-or for signal transformation." The Applicant accepts all the Examiner's admissions.

All of the 103 arguments with respect to Claims 1 and 5 discussed above are incorporated herein by reference.

19 of 21

LESAVICH HIGH-TECH
LAW GROUP, P.C.
SUITE 325
39 SOUTH LA SALLE STREET
CHICAGO, ILLINOIS 60603
TELEPHONE (312) 332-2701

RESPONSE TO OFFICE ACTION MAILED AUGUST 28, 2003
Patent Application No. 09/734,432

Claim 7 is a dependent claim that adds additional limitations to the invention not taught by the cited references. Since the Applicant has clearly pointed out why the Independent claims are not obvious, their corresponding dependent claims are not obvious.

Therefore, the Applicant now requests the Examiner immediately withdraw the §103 rejections with respect to Claim 7. Since this claim is not obvious it should be immediately allowable in its present form.

20 of 21

LESAVICH HIGH-TECH
LAW GROUP, P.C.
SUITE 325
95 NORTH LA SALLE STREET
CHICAGO, ILLINOIS 60603
TELEPHONE (312) 332-3751

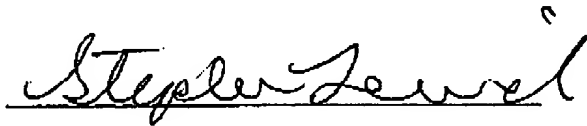
RESPONSE TO OFFICE ACTION MAILED AUGUST 28, 2003
Patent Application No. 09/734,432

CONCLUSION

The prior art made of record in the Office Action but not relied upon by the Examiner is no more pertinent to Applicant's invention than the cited references for the reasons given above. The Applicant therefore submits that all of the claims in their present form are immediately allowable and requests the Examiner withdraw the §103 rejections of claims 1-11 and pass all of the pending claims 1-20 to allowance.

Respectfully submitted.

Lesavich High-Tech Law Group, PC (32097)



Dated: February 27, 2004

Stephen Lesavich, PhD
Reg. No. 43,749

Voice: 312.332.3751

21 of 21

LESAVICH HIGH-TECH
LAW GROUP, P.C.
SUITE 320
39 SOUTH LASALLE STREET
CHICAGO, ILLINOIS 60603
TELEPHONE (312) 232-3751